## REMARKS

Applicants appreciate the Examiner's thorough examination of the subject application and request reconsideration of the subject application based on the foregoing amendments and the following remarks.

Applicants respectfully request a telephone interview with the Examiner to further discuss Applicants response to the within rejection of the pending claims. As such, Applicants respectfully request that the Examiner contact the undersigned prior to issuance of Advisory Action.

Claims 1-9 are pending in the subject application.

Claims 1-9 stand rejected under 35 U.S.C. §103.

### 35 U.S.C. §103 REJECTIONS

Claims 1-9 stand rejected under 35 U.S.C. §103 as being unpatentable over Takehara et al. [USP 6,290,220; "Takehara"] in view of Shiraishi [USP 6,445,891"].

In the Office Action its is asserted that Takehara teaches an image forming apparatus having a sheet eject mechanism which is moveable between an initial position and a sorting position and a control device for controlling the sheet feeding mechanism via sensors. In this regard, the Office Action asserts that the features identified by reference numerals 7, 180b and 140 correspond to the sheet ejection mechanism of the present invention. Applicants respectfully disagree with this characterization of what is being taught and disclosed in Takehara.

The Office Action also admits that Takehara does not clearly teach the control device that regulates a delay time required for the sheet mechanism moving from an initial position to the sorting or other position. It is further asserted that Shiraishi teaches a control device which regulates the delay time for the sheet eject mechanism moving from a position to other position via the initial sensor, the timing sensors and an offset motor. Applicants respectfully traverse.

Although held in connection with a rejection under 35 U.S.C. §102, the Federal Circuit has indicated that in deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify *corresponding elements* disclosed in the allegedly anticipating reference (emphasis added, citations in support omitted). *Lindemann Maschinenfabrik GMBM v. American Hoist and Derrick Company et al.*, 730 F. 2d 1452, 221 USPQ 481,485 (Fed. Cir. 1984). In concluding that the `770 Patent did not anticipate the claims, the Federal Circuit in *Lindemann Maschinenfabrik GMBM v. American Hoist and Derrick Company et al.*, at 221 USPQ 485-486, further provides that:

> The `770 patent discloses an entirely different device, composed of parts distinct from those of the claimed invention, and operating in a different way to process different materials differently. Thus, there is no possible question of anticipation by equivalents. Citations omitted.

In the subject application, it is clear that the sheet ejection mechanism is the mechanism from which the sheets being processed are ejected from and received on a receiving device, the tray. It also is clear from the claims of the subject application, that it is this mechanism, which is being

moved from an initial position to a sorting position in a direction that is orthogonal to the sheet transport direction. In light of the foregoing, it is respectfully submitted that the features identified by reference numerals 7, 180b and 140 cannot correspond, to a sheet ejection mechanism of the present invention as hereinafter described.

These features in Takehara correspond to the discharge rollers 7, the bundle discharge roller (transferring means) 180b, and an aligning means 140 that is operably disposed on the intermediate tray 140 or the treating tray. As described in Takehara when sheets are processed, they are ejected from the discharge rollers 7 to the treating or intermediate tray 130 (a first staking tray) and the alignment means acts on the bundle of sheets accumulated on the treating tray so as to shift these sheets into one of first or second aligning positions. The transferring means, the bundle discharge roller, is actuated at some time during the process so a bundle of sheets, for example the bundle of sheets corresponding to a copy of a document, that are accumulated on the treating tray are in transferred in their sorted condition to the second staking tray. In sum, the allegedly corresponding features in Takehara disclose an entirely different device, composed of parts distinct from those of the claimed invention, and operating in a different way to process different materials differently. Thus, it is respectfully submitted that that the allegedly corresponding elements disclosed in Takahara do not in fact correspond to the elements of the claimed invention. It also is clear that the apparatus described in Takehara functions and operates in a different manner from that of the claimed invention. Thus, it cannot be said that Takhara discloses, teaches or suggest in anyway Applicants' invention.

In view of the foregoing Applicants, do not believe that it is necessary to further distinguish the secondary reference beyond noting that this reference does not, and cannot, provide any disclosure nor teaching that overcomes the underlying shortcomings in the primary reference.

As claims 2-4 each depend from claim 1, it is respectfully submitted that each of these claims are allowable at least because of their dependency from a base claim that is considered allowable.

Applicants also respectfully submit that the foregoing remarks distinguishing the image forming apparatus of claim 1 from the combination of references also applies to distinguish the image forming apparatus of claim 5 from the cited combination of references. As was preciously indicated by Applicants, there is no discussion in either of the two references to compare the transport interval with a preset reference transport interval and controlling the image forming speed so as to be either of a first image forming speed under certain conditions and a second image forming speed under other conditions based on such a comparison. Further, there is no indication in either of the two references of image forming speed, much less a discussion that the operation of either described image forming apparatus could be intentionally altered so that the image forming operation or process could proceed at a different rate.

As is clear from the subject application, the image forming speed is the speed at which copying is conducted or images are formed. Moreover, there is no discussion in either Takehara or Shiraishi of controlling the image forming speed by reducing the speed in cases where it is determined that the transport interval is less than a predetermined value. In the illustrative

example provided in the subject application, the first image forming speed is indicated as being 26 ppm and the second image forming speed is 24 ppm.

As claims 6-9 each depend from claim 5, it is respectfully submitted that each of these claims are allowable at least because of their dependency from a base claim that is considered allowable.

As provided in MPEP 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As provided above, the references cited, alone or in combination, include no such teaching, suggestion or motivation.

Furthermore, and as provided in MPEP 2143.02, a prior art reference can be combined or modified to reject claims as obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 19866). Additionally, it also has been held that if the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. Further, and as provided in MPEP-2143, the teaching or suggestion to make the claimed combination and the reasonable suggestion of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d

488, 20 USPQ2d 1438 (Fed. Cir. 1991). As can be seen from the forgoing discussion regarding the disclosures of the cited references, there is no reasonable expectation of success provided in either Takehara or Shiraishi. Also, it is clear from the foregoing discussion that the modification suggested by the Examiner would change the principle of operation of the image forming apparatus disclosed in Takehara.

As provided by the Federal circuit, a 35 U.S.C. §103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in a reference, is not proper and the prima facie case of obviousness cannot be properly made. In short there would be no technological motivation for engaging in the modification or change. To the contrary, there would be a disincentive. *In re Gordon*, 733 F. 2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case it is clear that if the image forming apparatus disclosed in Takehara was modified in the manner suggested by the Examiner it would destroy the intent, purpose or function of the device as taught by the reference.

It is respectfully submitted that for the foregoing reasons, claims 1-9 are patentable over the cited reference(s) and satisfy the requirements of 35 U.S.C. §103. As such, these claims are allowable.

It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

Applicants believe that additional fees are not required for consideration of the within Response. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. **04-1105**.

Respectfully submitted,
Edwards & Angell, LLP

Date: May 12, 2005

By: William J Daley

William J. Daley, Jr.
(Reg. No. 35,487)
P.O. Box 55874
Boston, MA 02205
(617) 439- 4444

Customer No. 21,874

Bos2_479008.2